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No. 07-186

FILED
OCT 9 - 2007
OFFICE OF THE CLERK
SUPREME COURT, U.S.

IN THE

Supreme Court of the United States

CROSS MEDICAL PRODUCTS, INC.,

Petitioner,

v.

MEDTRONIC SOFAMOR DANEK, INC. and MEDTRONIC SOFAMOR DANEK USA, INC.,

Respondents.

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE FEDERAL CIRCUIT

BRIEF IN OPPOSITION

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October 9, 2007

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QUESTION PRESENTED

Whether the Court of Appeals for the Federal Circuit found correctly, under the facts of this case, that the rationale underlying plaintiff's narrowing amendment to its patent claim bore more than a tangential relation to the accused equivalent, such that plaintiff could not rebut the presumption of prosecution history estoppel.

PARTIES TO THE PROCEEDINGS AND RULE 29.6 STATEMENT

Respondents Medtronic Sofamor Danek, Inc. and Medtronic Sofamor Danek USA, Inc., are defendants and counter-claimants in the district court proceedings and were appellants in the court of appeals proceedings. Counter-claimant SDGI Holdings, Inc. is a party to the district court proceedings only.

Respondents and counter-claimants are wholly owned subsidiaries of Medtronic, Inc., a publicly traded corporation. No publicly held company owns 10% or more of Medtronic, Inc.

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CONSTITUTIONAL AND STATUTORY PROVISIONS INVOLVED

In addition to Article 1, Section 8, Clause 8 of the United States Constitution, and 35 U.S.C. § 271(a), cited by Petitioner, this case also involves 35 U.S.C. § 112 and 35 U.S.C. § 102(b).

The relevant paragraphs of § 112 state:

¶ 1. The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same, and shall set forth the best mode contemplated by the inventor of carrying out his invention.

¶ 2. The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicants regards as his invention.

The relevant section of 35 U.S.C. § 102 states:

A person shall be entitled to a patent unless–

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of the application for patent in the United States.

JURISDICTION

While this Court has jurisdiction under 28 U.S.C. § 1254(1), it should be noted that this is an interlocutory appeal. The Court of Appeals for the Federal Circuit, after reversing and vacating the District Court's summary judgment rulings on invalidity and infringement, remanded the case to the District Court for further proceedings consistent with the two opinions that the Federal Circuit has issued in this case. Pet. App. 17a.

STATEMENT OF THE CASE

This case is currently pending in the District Court for the Central District of California. Pet. App. 112a. The District Court was instructed by the Federal Circuit to conduct further proceedings on Petitioner's claims of infringement and respondents' affirmative defenses and counterclaims of invalidity consistent with the two opinions rendered by the Federal Circuit in this case to date. Pet. App. 17a, 110a. Discovery is ongoing and there are unresolved issues of noninfringement (Pet. App. 92a, 98a, 101a) and invalidity (Pet. App. 109a) that have to be resolved at the District Court before respondents can be found liable for infringement of Petitioner's patent. Pet. App. 17a.

As with any patent litigation, the events that transpired before the patent issued can be as relevant as the current procedural posture in determining whether review is appropriate. This is particularly true where, as here, the sought-after review would only apply to a narrow set of facts that are unlikely to provide a

basis for a rule of law of general applicability. When the application for the patent-in-suit was undergoing examination at the Patent & Trademark Office ("PTO"), the patent applicants made several narrowing amendments to the claim at issue here in response to a rejection under, *inter alia*, 35 U.S.C. § 112 and ¶ 2 and 35 U.S.C. § 102(b). *Cross Med. Prods., Inc. v. Medtronic Sofamor Danek, Inc.*, 480 F.3d 1335, 1340 (Fed. Cir. 2007) (Pet. App. 6a).[1]

As discussed in more detail below, one of the amendments to the patent claim at issue added a narrowing limitation on the depth of threads on a device, specifically requiring that they extend "to a depth below the diameter of the rod." Pet. App. 7a. The products accused of infringement here have threads that terminate above the rod, (Pet. App. 7a), thus precluding literal infringement. Pet. App. 9a. Infringement can only lie if (1) the threads terminating above the rod are equivalent to threads extending below the rod and (2) the patentee is not estopped from asserting infringement under the doctrine of equivalents. *Id.* However, when the applicants made a narrowing amendment for purposes of patentability, they created a presumption of prosecution history estoppel foreclosing reliance on the doctrine of equivalents for the amended claim elements when the patent eventually issued. *See Warner-Jenkinson Co. v. Hilton Davis Chem. Co.*, 520 U.S. 17, 33 (1997) (stating that a presumption of prosecution history estoppel arises from amendments made to a patent claim during prosecution for

1. References to the decision below will heretofore be made to the appropriate page in Petitioner's Appendix.

"a substantial reason related to patentability."). This presumption may be rebutted if the rationale underlying the amendment bears "no more than a tangential relation" to the accused equivalent, *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 535 U.S. 722, 740 (2002) ("*Festo VIII*").

Here, the rationale underlying the amendment was "to capture the manner in which the stabilizer aspect of the invention operated and thereby overcome the 35 U.S.C. § 112 rejections." Pet. App. 12a. The Court of Appeals correctly decided that the rationale underlying the amendment could not be tangential to the accused equivalent. *Id.* The Court of Appeals then ruled correctly that the Petitioner is estopped from reliance upon the doctrine of equivalents. Pet. App. 14a.

I. HISTORY OF U.S. PATENT NO. 5,574,555

The patent-in-suit, U.S. Patent No. 5,474,555 ("the '555 patent"), issued from a continuation application of a previous ("parent") patent. *Cross Med. Prods. Inc. v. Medtronic Sofamor Danek, Inc.*, No. 05-1415 (Fed. Cir. Dec. 12, 2005), Non-Confidential Joint Appendix.[2] A0182. The claims filed originally with the PTO, as well as the figures in both the parent and continuation applications, all included a cap between a nut and the rod. Pet. at 4; A2284-87. The length of the threads did not have to be specified, because of the intervening cap. Pet. at 5. During prosecution of the '555 patent application, the applicants added new claims without the cap limitation. *Id.*; A2314-18.

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2. Subsequent references to this joint appendix will be identified only by "A."

When the claim that ultimately issued as claim 5 was first added, it specified "first threads" without any further details or limitations on these threads. A2316. This claim was deemed unpatentable by the patent examiner and rejected for numerous reasons, including, *inter alia*, inadequate written description, indefiniteness, and anticipation. A2324-28. The examiner rejected the claim as indefinite under 35 U.S.C. § 112 ¶ 2, because "[s]aid anchor seat portions" of the claimed device had no positive antecedent basis." A2325. The examiner also rejected the claim under 35 U.S.C. § 112 ¶ 1 for failing to provide an adequate written description of the invention, because certain limitations of the claim "fail[ed] to have support in the specification." A2327. The examiner rejected claim 5 further under 35 U.S.C. § 102(b) "as being clearly anticipated by Puno et al '602," referring to U.S. Patent No. 4,805,602. A2328. Finally, the examiner rejected the claim for obviousness type double patenting over the parent, U.S. Patent No. 5,360,431. Pet. App. 6a.

It was not just the claims that were deemed deficient by the examiner; he also found that the patent specification "fail[ed] to provide an enabling description of the embodiment of the action device excluding the cap/cap means. . . ." A2327. In order to persuade the PTO that the claim at issue was patentable, the applicants had to (1) amend the specification by adding a description enabling what was claimed, and (2) amend the claim to particularly point out and distinctly claim the subject matter of their invention. They did so by, *inter alia*, specifying how far the first threads extend in the claimed apparatus. Pet. App. 12a.

The examiner and the applicants then agreed, in a telephone interview, that, *inter alia*, the claims had to be amended "to reflect the above (i.e., the nut having a constant diameter bore and the external threads extending beyond the diameter of the rod)." A2332. The resulting amendment added the following limitation to the claimed first threads:

> . . . said seat means including a vertical axis and first threads *which extend in the direction of said vertical* axis *toward said lower bone interface to a depth below the diameter of the rod when it is in the rod receiving channel* . . .

A2337 (emphasis added). In their remarks accompanying the amendment, the applicants stated unambiguously that:

> In response to the rejection under 35 U.S.C. §112 of the specification as well as the claims, the specification has been amended to recite the invention specifically shown in Figures 2 and 4. Accordingly, the claims have also been amended to define the anchor seat means having a channel *and threads which cooperate with the securing means* [i.e., the nut] so as to capture the stabilizer [i.e., rod] between the channel and the securing means since *the ancor* [sic] *seat threads extend toward the channel to a depth below the top of the stabilizer when it is in the channel.*

A2338 (emphasis added). These amendments are evidence that the claimed invention worked, in the

applicants' own words, "since" the anchor seat threads extend to a depth below the top of the stabilizer rod, thus allowing the threads to cooperate with the securing means (i.e., the nut to be screwed down upon the threads) to capture the stabilizer. Although the prosecution history is devoid of any explanation as to how the claim amendments overcame the examiner's additional objection under § 102(b), the patent examiner allowed the amended claim to issue. A2340.

By specifying that the threads extend "below the top of the stabilizer," the applicants narrowed their claim. The Federal Circuit held that "the thread depth limitation was added to capture the manner in which the stabilizer aspect of the invention operated and thereby overcome the 35 U.S.C. § 112 rejections." Pet. App. 12a. The accused equivalent had threads that stopped at the *top* of the stabilizer, and thus did not include the limitation added in the amendment—the very limitation that made the claim patentable. The Federal Circuit decided, on the basis of the undisputed facts of the case as laid out in the prosecution history of the '555 patent, that the amendment adding this limitation could not be tangential to the accused equivalent. *Id.* (stating that the accused equivalent "does *not* include threads extending 'to a depth below the top of the stabilizer' and correspondingly does *not* capture this aspect of the invention.") (emphasis in original). The Federal Circuit ruled correctly that the plaintiff failed to meet its burden and rebut the presumption of prosecution history estoppel, and is therefore estopped from asserting infringement under the doctrine of equivalents. *Id.*

REASONS FOR DENYING THE PETITION

Respondents Medtronic Sofamor Danek, Inc., and Medtronic Sofamor Danek USA, Inc., respectfully request that this Court deny Cross's petition for a writ of certiorari for the following reasons:

First, the case currently stands in an interlocutory posture because the Court of Appeals remanded the case for continued proceedings at the District Court, and Petitioner has not shown any exceptional or compelling reason for this court to depart from its ordinary practices and entertain this petition while issues remain unresolved below.

Second, the question presented by the petition is so vague and unbounded that it does not provide the proper notice to respondents or aid this court in framing the dispute, and does not meet the requirements of Supreme Court Rule 14.1(a) in that it is argumentative and not presented "in relation to the circumstances of the case."

Third, this case presents no new question of law for consideration by this Court because it is an intensely factbound application of the properly stated law of this Court and the Federal Circuit to the particular facts of this case.

Fourth, the Federal Circuit applied the established law correctly.

Fifth, this case presents no conflict, whether among circuits, within the Federal Circuit, or with this Court.

Sixth, this case presents no action by the Federal Circuit, such as formulation of a new "test" for estoppel, that is in opposition to any judgment by this Court.

A. The Interlocutory Posture of This Case Makes Review Inappropriate.

This case is currently pending in the District Court for the Central District of California. Pet. App. 112a. In this case, the District Court was instructed by the Federal Circuit to conduct further proceedings on Petitioner's claims of infringement and respondents' affirmative defenses and counterclaims of invalidity consistent with the two opinions rendered by the Federal Circuit in this case to date. Pet. App. 17a, 110a. Discovery is ongoing and there are unresolved dispositive issues of infringement (Pet. App. 92a, 98a, 101a) and validity (Pet. App. 109a) that must be resolved below before respondents can be found liable. Pet. App. 17a.

Any decision on this petition will not resolve this case because there are three remanded infringement issues that are particularly relevant to the non-infringement ruling that Petitioner seeks to have reviewed here. When the Federal Circuit ruled on the first appeal in this case (which is not the subject of this petition), it reversed *three* of the District Court's determinations on summary judgment: first, that the claim limitation of "operatively joined" was met by Medtronic's accused products, Pet. App. 92a; second, that the claim limitation of "securing means" was met by Medtronic's accused products, Pet. App. 98a; and third, that the claim limitation of "bear against said channel" was met by Medtronic's accused products. Pet. App. 101a. These

issues must be tried, in the first instance, in the District Court, and favorable resolution of any or all of them will result in a finding of non-infringement regardless of this Court's decision on this petition. Finally, even if infringement is found, the patent claim could be found invalid as obvious, (Pet. App. 106a - 109a), precluding Medtronic from liability for infringement. *See* 35 U.S.C. § 282.

Ordinarily, this Court will not grant review in the interlocutory posture of this case. *Bhd. of Locomotive Firemen & Enginemen v. Bangor & Aroostook R.R. Co.*, 389 U.S. 327, 328 (1967) ("[B]ecause the Court of Appeals remanded this case, it is not yet ripe for review by this Court.") (citing *Hamilton-Brown Shoe Co. v. Wolf Bros. & Co.*, 240 U.S. 251, 257-58 (1916) ("The decree that was sought to be reviewed by certiorari at complainant's instance was not a final one, a fact that of itself alone furnished sufficient ground for the denial of the application . . .")). *See also Va. Military Inst. v. United States*, 508 U.S. 946, 946 (1993) (Scalia, J., concurring) ("We generally await final judgment in the lower courts before exercising our certiorari jurisdiction."). There is no special or compelling reason for this Court to depart from its ordinary course and exercise review here.

B. The Question Presented By Petitioner Does Not Satisfy The Requirements of This Court's Rule 14.1(a)

This Court's Rule 14.1(a) requires that the question presented is "expressed concisely in relation to the circumstances of the case," and not "argumentative or repetitive." There are two reasons for this rule. First,

"it provides the respondent with notice of the grounds upon which the Petitioner is seeking certiorari, and enables the respondent to sharpen the arguments as to why certiorari should not be granted." *Yee v. City of Escondido*, 503 U.S. 519, 535-36 (1992). Second, it "assists the court in selecting the cases in which certiorari will be granted," by identifying the specific "particularly important questions" and thus "enabl[ing] the Court to use its resources efficiently." *Id.*

Petitioner's "Question Presented," "[s]hould the Federal Circuit's material alteration of this Court's important precedent be permitted?" is argumentative in its erroneous assumption that the Federal Circuit has "materially altered" this Court's legal precedent. In so doing, Petitioner attempts to elevate the Federal Circuit's straightforward application of the law to the very particular facts of this case, to a question of national significance that is not supported on these facts.

The Petitioner's question also disregards the additional requirement of Rule 14.1(a) that the question be presented "in relation to the circumstances of the case." This case presents the specific question of whether the presumption of prosecution history estoppel is rebutted for a specific alleged equivalent to a patent claim limitation that was added in response to a rejection under § 112 and other statutory provisions. Petitioner's question glosses over this narrow context of the decision below and ignores the direct dependence of the outcome on the particular facts in the prosecution history of the patent in suit, and the specific accused equivalent. By ignoring the factual foundation on which any decision in this area is built, Petitioner's question is of no aid in framing the dispute.

As presented, this question would not serve the purpose of delineating the scope of the briefing and argument, in the event of plenary review. That lack of guidance would "thwart" the "integrity of the process of certiorari." *See Taylor v. Freeland & Kronz*, 503 U.S. 638, 646 (1992). The inadequate question presented by Petitioner is a sufficient reason, in and of itself, to deny certiorari.

C. Determination Of The Scope Of Estoppel Under The Doctrine Of Equivalents Is An Intensely Factbound Application Of The Law To The Particular Facts Of Each Case And The Decision Below Presents No Clear-Cut Question Of Law For Consideration By This Court.

Whether prosecution history estoppel applies to a particular claim element and an accused equivalent structure is a question of law that is heavily dependent upon the specific facts of each case. *Warner-Jenkinson*, 520 U.S. at 39 ("[U]*nder the particular facts of a case*, if prosecution history estoppel would apply . . . partial or complete judgment should be rendered by the court ") (emphasis added). Facts affecting the scope of estoppel include: what was specifically surrendered by the applicant during prosecution; what was given up by the applicant during argument in the PTO during prosecution; and, if the claims were amended in response to a prior art rejection, the prior art. *See, e.g., Litton Sys., Inc. v. Honeywell, Inc.*, 140 F.3d 1449, 1462 (Fed Cir. 1998).

In addition to the prosecution history, the nature of the alleged equivalent must be analyzed because estoppel

is not evaluated in a vacuum, but rather in the context of the accused equivalent. This analysis is akin to the analysis of infringement under the doctrine of equivalents itself, in which

> [a]n analysis of the role played by *each element* in the context of *the specific patent claim* will thus inform the inquiry as to whether a substitute element matches the function, way, and result of the claimed element, or whether the substitute element plays a role substantially different from the claimed element.

Warner-Jenkinson, 520 U.S. at 40 (emphasis added). Thus, in determining whether estoppel applies to a particular accused equivalent, the prosecution history, the specific patent claim, and the accused equivalent must all be analyzed in a detailed fact-specific inquiry.

The petition itself, replete with many, but not all, of the facts necessary to understand this case, demonstrates the factual dependence of findings in this area. The petition describes the transactions between applicant and PTO that resulted in the patent, Pet. at 4-5.; the nature of the specific accused equivalent device, Pet. at 6-8, and the factual foundation for the Federal Circuit's decision, Pet. at 9. Not only this case, but every case involving the determination of the scope of prosecution history estoppel, is intensely fact-bound. While every case is, of course, dependent upon the facts, the almost entirely factual nature of this analysis precludes this case from having the national importance justifying review by this court. *See United States v. Johnston*, 268 U.S. 220, 227 (1925) ("We do not grant a certiorari to review evidence and discuss specific facts.").

D. The Federal Circuit Faithfully Applied This Court's and the Federal Circuit's Law To These Facts When Deciding That Plaintiff Failed to Rebut the Presumption of Prosecution History Estoppel.

The decision below was faithful to both this Court's precedent and Federal Circuit law founded on that precedent. The Federal Circuit applied the principles set forth by this court in *Warner-Jenkinson* and *Festo VIII* when it determined the scope of the subject matter surrendered after determining that a narrowing amendment was made for a substantial reason relating to patentability. *Festo VIII* imposes the presumption that the patentee has surrendered all of the territory that lies between the original and amended claim limitations. *See Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co., Ltd.*, 344 F.3d 1359, 1367 (Fed. Cir. 2003) ("*Festo IX*") (citing *Festo VIII*, 535 U.S. at 740). *Festo VIII* further instructs that the patentee may rebut the presumption of surrender by demonstrating that the rationale underlying the narrowing amendment bore no more than a tangential relation to the equivalent in question, i.e., was not directly relevant, was only slightly connected to, or was "merely touching" the equivalent in question. *See Festo IX*, 344 F.3d at 1369 (citing *Festo VIII*, 535 U.S. at 740, and two dictionaries).

The Federal Circuit correctly applied this precedent, in accord with *Festo IX*, in the instant case. The Federal Circuit first ascertained the facts, determining that the patent applicants made a narrowing amendment for "patentability"— i.e., to overcome the rejection on the basis of § 112 ¶ ¶ 1-2, and § 102(b). Pet. App. 6a. The appeals court then determined that the scope of the

surrendered subject matter encompassed the accused equivalent. Pet. App. 12a. Next, the court below determined the rationale for the narrowing amendment, finding that "the thread depth limitation was added to capture the manner in which the stabilizer aspect of the invention operated and thereby overcome the 35 U.S.C. § 112 rejections." *Id.* Finally, the Federal Circuit applied the law to these facts and concluded, as a matter of law, that this rationale was not tangential to the accused equivalent because the accused equivalent "does *not* include threads extending 'to a depth below the top of the stabilizer' and correspondingly does *not* capture," i.e., use, the very aspect of the invention that the applicants particularly and distinctly described in order to satisfy the statutory requirements for the claim.

The Federal Circuit's examination of the question of tangentialness in the instant case is an uncompromised application of the principles of estoppel, and rebuttal of the presumption of estoppel, laid down by this Court in *Festo VIII* and in *Warner-Jenkinson*. Although this Court did not define "tangential" in *Festo VIII*, the meaning of the word is implicit in the decision: certainly, an amendment is not tangential if it "does not surrender the particular equivalent in question," because "amendment may be presumed to be a general disclaimer of the territory between the original claim and the amended claim." *Festo VIII*, 535 U.S. at 740. Here, the Federal Circuit examined the question of disclaimed territory and concluded that the amendment was *central* to the issue of tangentiality because it *explicitly* excluded the thread depth of the accused equivalent from the claim.

The rationale stated by the applicants did not implicate prior art. They clearly stated that they added the thread depth claim limitation because that was what they thought they invented and how they had to claim it to satisfy the statutory requirements. Pet. App. 12a; A2338. Under the facts of this case, and following its own consistent interpretation of *Festo* and *Warner-Jenkinson*, the Federal Circuit made the correct decision here.

E. The Federal Circuit's Decision In This Case Is Consistent With Other Federal Circuit Decisions.

Comparison of this case with the other post-*Festo* decisions establishes that the Federal Circuit's holding in this case is consistent with other Federal Circuit decisions involving tangentialness.[3] Any differences in results arise because of different facts, as expected from

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3. *See Amgen Inc. u Hoechst Marion Roussel, Inc.*, 457 F.3d 1293, 1313-15 (Fed. Cir. 2006); *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841, 849 (Fed. Cir. 2006); *Biagro W. Sales, Inc. v. Grow More, Inc.*, 423 F.3d 1296, 1306 (Fed. Cir. 2005); *Research Plastics, Inc. v. Fed. Packaging Corp.*, 421 F.3d 1290, 1299 (Fed. Cir. 2005); *Terlep v. Brinkmann Corp.*, 418 F.3d 1379, 1385-86 (Fed. Cir. 2005); *Rhodia Chimie v. PPG Indus.*, 402 F.3d 1371, 1382-83 (Fed. Cir. 2005); *Bus. Objects, S.A. v. MicroStrategy, Inc.*, 393 F.3d 1366, 1374 (Fed. Cir. 2005); *Insituform v. CAT Contr., Inc.*, 385 F.3d 1360, 1368-71 (Fed. Cir. 2004); *Mycogen Plant Sci., Inc. v. Monsanto, Co.*, 91 Fed. Appx. 666, 669 (Fed. Cir. 2004) (nonprecedential); *Glaxo Wellcome, Inc. v. Impax Labs., Inc.*, 356 F.3d 1348, 1357 (Fed. Cir. 2004); *Talbert Fuel Sys. Patents Co. v. Unocal Corp.*, 347 F.3d 1355, 1360 (Fed. Cir. 2003); *Okor v. Atari Games Corp.*, 76 Fed. Appx. 327, 332-33 (Fed. Cir. 2003) (nonprecedential); *Festo Corp. v. Shoketsu Kinzoku Kogyo Kabushiki Co.*, 344 F.3d 1359, 1371-72 (Fed. Cir. 2003); *Pioneer Magnetics, Inc. v. Micro Linear Corp.*, 330 F.3d 1352, 1357 (Fed. Cir. 2003).

the intensely factual analysis required. The Federal Circuit's findings of both tangentiality and non-tangentiality, dependent upon the facts in each case, belies Petitioner's accusation that that court has "eviscerated" this Court's "tangential relation test." Pet. App. 15.

As an example of a Federal Circuit decision both internally consistent and consistent with this Court's *Festo VIII*, the appellate court ruled that the rationale for an amendment was not tangential in *Research Plastics, Inc. v. Fed. Packaging Corp.*, 421 F.3d 1290 (Fed. Cir. 2005). In *Research Plastics*, the invention involved the placement of ribs on the interior surface of a caulking tube. *Id.* at 1292. During prosecution, the Examiner rejected the claims as obvious over a prior art patent claiming the use of ridges similar to the ribs in the patent-in-suit, but the prior art ridges were positioned near the nozzle end of the tube. *Id.* at 1293. In response to the rejection, the patentee amended the claims by adding the following language: "said ribs each occupying an area that is less than 0.5% of the area of said tube, and said ribs extending to said rear end of said hollow tube body." *Id.* (emphasis added). The patentee therefore disclaimed ribs positioned adjacent to the nozzle (opposite) end of the tube. *Id.* at 1298.

In *Research Plastics*, the accused equivalent had tubes with ribs located some distance from the rear edge of the tube's interior wall but still within the rear half of the tube and well away from the nozzle. *Id.* The Federal Circuit decided that the patentee could not expand the scope of its patent to cover the accused equivalent for the same reason set forth in this case: the patentee

amended its claims in response to a rejection for patentability purposes, disclaiming the very feature of the accused equivalent that it was now trying to cover. The Federal Circuit noted that "the alleged equivalent—ribs extending to a point short of the rear edge of the tube—is not tangential to the purpose of the amendment, because the purpose of the amendment was to avoid rejection based on rib placement." *Id.* at 1299.

Here, as the Federal Circuit recognized correctly, both the purpose of the amendment was to avoid rejection based on thread placement, and that rationale is not tangential to the thread placement in the accused devices. In both *Research Plastics* and *Cross*, the Federal Circuit correctly applied the facts of the case according to the principles laid down in *Festo VIII*.

The Federal Circuit has also found amendments to be tangential where the facts warrant such a finding. The court's approach in these cases further demonstrates its internal consistency, as well as its consistent adherence to the principles laid down in *Festo VIII*. For example, in *Insituform Techs., Inc. v. CAT Contr., Inc.*, 385 F.3d 1360 (Fed. Cir. 2004), the claim in question covered a method of resin coating an absorbent tubular liner on the interior of, e.g., underground pipes. 385 F.3d. at 1362. The resin was introduced in bulk at one end of the tube and drawn into the tube by a vacuum applied downstream through a cup attached to a hole in the outer wall of the tube. *Id.* at 1363. As the resin reached the cup, the cup was moved to a point farther downstream. *Id.*

During prosecution, the *Insituform* applicant had to overcome a prior art rejection based on an invention that used a single vacuum source fixed at the far end of the

tube. *Id.* at 1370. The original claim did not limit the number of vacuum sources. 385 F.3d. at 1366. The applicant amended the claim to include a single movable cup. *Id.* On the basis of the applicant's explanation of the amendment in the prosecution history, the Federal Circuit found that the rationale for the amendment was to differentiate applicant's method of applying a vacuum at multiple points on the tube by using a cup movable along the length of the tube, from the prior art method of using a single vacuum source at the end of the tube. *Id.* at 1369. However, the accused equivalent was a multiple cup system that also applied the vacuum at multiple locations. *Id.* at 1370. The Federal Circuit concluded that the amendment was tangential to the accused equivalent, because it related to an entirely different aspect of the invention than that which was accused of equivalence. *See id.* In other words, "an amendment based on *where* the vacuum source was located was only tangentially related to an equivalent directed at the *number* of vacuum sources." Pet. App. 11a (reconciling *Insituform* with this case) (emphasis in original). *See also Insituform*, 385 F.3d at 1370.

The Federal Circuit applied the same tangentiality analysis in *Insituform* and in this case, and obtained different results because different facts applied. The Federal Circuit decided that the *Insituform* amendment was tangential because it related to a different aspect of the invention than that implicated in the accused equivalent: the rationale underlying the amendment concerned the *location* of the vacuum source, while the equivalence hinged on the *number* of vacuum sources. Here, in contrast to *Insituform*, the amendment was not tangential because it related to precisely the same aspect of the invention, the thread depth, that is implicated in the accused equivalent.

Pet. App. 12a. The same legal analysis that led the Federal Circuit to find tangentiality in *Insitufor* led to a finding of lack of tangentiality here because different facts mandated different results.

F. The Federal Circuit Has Neither "Eviscerated" The Tangential Relation Principle Nor Created A New Test.

The Federal Circuit's application of *Festo VIII* has hardly "eviscerated" the tangential relation principle, not withstanding Petitioner's melodramatic assertion to the contrary. The court has found amendments to be tangential in one-seventh (~14%) of the fourteen cases involving tangentialness that have come before the Federal Circuit since *Festo VIII*.[4] Plainly, the tangentialness test is not "virtually insurmountable," as Petitioner argues. Pet. at 19. The tangential rebuttal principle is narrow and will only rarely provide a basis on which the patentee can rebut the statutory presumption, *see* Pet. App. 18a, but it is only one of these ways in which a patentee may rebut a presumption that this Court has ruled should apply. The two decisions since *Festo VIII* in which an amendment has been found tangential show that the Federal Circuit has not "eviscerated" the principle, particularly in view of the burdens that must be surmounted and the relatively few numbers of cases in which this issue has arisen.

The appeals court correctly stated and applied the law to the particular facts of this case. It did not apply a "new test" or disregard the rationale for the amendments. To the contrary, it determined the rationale underlying the

4. *Instituform Tech., Inc. v. CAT Contracting, Inc.*, 385 F.3d 1360 (Fed. Cir. 2004); *Primos, Inc. v. Hunter's Specialties, Inc.*, 451 F.3d 841 (Fed. Cir. 2006).

amendment from the applicants remarks. Pet. App. 12a. Having made that determination, the Federal Circuit correctly ruled that the rationale was not tangential to the alleged equivalent and Cross failed to rebut the presumption.

CONCLUSION

This petition should be denied not least because no question of law suitable for review by this Court has been presented. The Federal Circuit, following the teachings of this Court, decided correctly under the facts of this case that the rationale underlying plaintiff's amendment bore more than a tangential relation to the accused equivalent, so that plaintiff could not rebut the presumption and meet its burden of proving that the amendment was not tangential to the equivalent in question.

There is no infringement under the doctrine of equivalents under the specific facts of this case because of prosecution history estoppel, as the Federal Circuit ruled correctly.

Respectfully submitted,

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October 9, 2007

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